

## **REMARKS**

Counsel would first like to acknowledge and thank Examiners Ferguson and Colilla for calling counsel and apologizing and advising counsel of their errors in the August 2005 Office Action. Per this recognition, that Office Action was withdrawn by the Examiners and the November 2005 Action issued.

By Applicant's prior amendment, Claims 1-50 and 53-58 were deleted and Claims 59-80 were added. Consequently, Claims 51, 52 and 59-80 were in the case.

Applicant believes the claims are allowable as written and as previously presented. The most recent Office Action only confirms this point. In this Action, the Examiner misapplies the prior art cited in an attempt to show the claims are obvious. When properly reviewed and applied to Applicant's pending claims and invention, the art becomes irrelevant.

Before discussing the merits of the Office Action, counsel would like to point out that the making of the present Office Action "Final" was premature. In the Action, the Examiner failed to note her reasons for making the Action final. Counsel reminds the Examiner that a second Office Action cannot be made final when an Examiner introduces a new ground of rejection, as she has done here, that is not necessitated by Applicant's amendment of the claims. MPEP §706.07(a). Applicant's prior amendments to the claims were to facilitate an understanding by the Examiner of the invention and caused by the Examiner's misreading and interpretation of the claims and prior art. The Examiner's misreading was continued in the August 3, 2005 Office Action and the present Office Action. Consequently, as with the prior Office Action of August 3, 2005, the finality of the present Office Action must be withdrawn by the Examiner.

As to the merits of the Office Action, the Examiner has again misread the invention and the prior art. Specifically, in the Office Action of November 25, 2005, the Examiner premises all of her rejections on the prior art to Rivin, US 2003/0185624 ("Rivin"). To the extent Rivin has any relevance (which it doesn't), it is that a keyword or Boolean search of the word "shim" would have identified this reference. To the extent Rivin uses the word "shim," it is for a different use and purpose than Applicant, and more importantly, it is structurally irrelevant and different than Applicant's shims or spacers.

It is clear that the Examiner failed to read, let alone appreciate, the Rivin reference. Even a cursory reading of the Abstract reveals that Rivin is premised on reducing friction between parts/components movable with respect to each other. The mechanisms in Rivin for reducing such friction are “shims,” located between the contacting members. To the extent these shims are used by Rivin, they are totally irrelevant to Applicant’s use of spacers. In particular, the Rivin shims are made to deform so as to relieve friction. Applicant’s spacers cannot deform, for to do so will defeat their purpose of providing uniform and equal elevation of the frame members. The Rivin Abstract is very telling on this point:

A mechanical wedge mechanism comprising base member (1), output member (3), and movable wedge member (2) in which frictional connections between mutually movable mechanical members are replaced with shear deformations in elastomeric shims (10,11) connecting respective surfaces of the members, thus effectively reducing frictional losses in the mechanism.

(Reference Numbers Added)

Rivin’s design was to replace bearings and lubricants between contact surfaces. He does this by separating the conforming surfaces of the mechanical members with “thin uniform thickness shims (layers) 12 and 13 made of an elastomeric (rubber-like) material.” (Rivin, para. 10, 11, 24). As such, compression of the elastomeric materials involves only redistribution of the specimen’s volume (e.g., by bulging at the non-loaded surfaces). (Rivin, para. 25). As set forth in Rivin’s FIG. 3, a cylindrical specimen 30 comprising rubber cylinder 31 bonded to upper 32 and lower 33 covers, is subjected to an axial compression force that does not change. The compression deformation is accompanied by bulging of rubber on the free (not loaded by forces) surfaces, thus creating convex bulges 34. (Rivin, para. 25). The examples used by Rivin apply the above to a collet chuck FIG. 5 and a saw blade for reciprocating saw (FIG. 7).

The shims or spacers of the present invention are generally uniform so as to uniformly and evenly lift the frame from the item to be printed upon. They act as spacers to increase the physical distance between the item to be printed upon and the frame holding the screen. The kit, or method, permit this to be done in a controlled and precise manner.

As to the rejected independent Claims 59 and 65, each calls for shims having a uniform predetermined thickness and each shim being adapted to be optionally positioned between a frame holder and the frame such that the shims of a set can be used simultaneously with all of the

frame holders in a number of different combinations to adjust and evenly increase the vertical distance between the frame and the item to be printed upon. Nothing in Rivin remotely resembles this structurally or in purpose.

Again, by way of example, in a system having two (2) frame holders, each set or pair of shims are used simultaneously with one shim from each set being used with each frame holder.

Thus, two (2) sets of shims (the sets are designated X and Y) can be used with the two (2) frame holders three (3) different ways:

**Frame Holder 1**

X

Y

XY

**Combination 1**

X

**Combination 2**

Y

**Combination 3**

XY

**Frame Holder 2**

Three (3) sets of shims (the sets are designated X, Y and Z) can be used with the two (2) frame holders six (6) different ways:

**Frame Holder 1**

X

Y

Z

XY

XZ

YZ

**Combination 1**

X

**Combination 2**

Y

**Combination 3**

Z

**Combination 4**

XY

**Combination 5**

XZ

**Combination 6**

YZ

**Frame Holder 2**

Clearly, the Rivin reference has no relevance to Applicant's invention. Moreover, the Rivin reference has no relevance to screen printing machines and the frame holders used therein. Since all claim rejections are based on Rivin and Rivin is not relevant or applicable, all of Applicant's claims distinguish over Rivin and the other art. All pending claims are allowable.

The Examiner's confusion is more clearly demonstrated by her citation of Deschenes, US 2002/0148172 ("Deschenes"). Deschenes discloses simple and double-width shims that are "wedge-shaped" or "tapered." This is the antithesis of Applicant's invention which requires spacers of uniform thickness. The Examiner's position that the shims of Deschenes are of different thickness to make certain claims obvious is a total misapplication of Deschenes. Deschenes' shims are of different thickness because the manufacturing of them is crude. Specifically, the paragraph (para. 31) cited by the Examiner makes this clear:

In practice, the two wood shims (10,12) of a same assembly are not equal length and thickness, as a result of the imprecision of the manufacturing process. It is understood that the precise and relative dimensions of the two wood shims (10,12) are not material to the present invention, which simply requires that the two shims are wedge-shaped and taper in the same direction.

It cannot be ignored that this teaches away from Applicant's spacers requiring predetermined, uniform thickness. Consequently, the Examiner's use and application of Deschenes is inappropriate.

The patent to Ingold (US 4,713,922) ("Ingold") merely shows the use of an adhesive or nail 24 driven into a fixed wedged-shape shim 12 or the use of a nail or wood screw passing through the jab 16. Applicant neither discusses or claims a nail, wood screw or adhesive in its application. Indeed, such a permanent connection is counter to Applicant's invention which calls for interconnecting of spacers so that different combinations of spacers may be obtained. Specifically, Claims 61 and 67 use the word "interconnect" and Claims 62 and 68 use the term "hold." Accordingly, Ingold is not relevant to Applicant's claimed invention and cannot be used to build an obviousness-type rejection.

Clearly, Applicant's invention patentably distinguishes over the art previously cited by the Examiner, cited in the most recent Office Action and cited in the file history. As such, the claims are allowable as written.

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If it would expedite the progress of this Application through the examination process, the Examiner is authorized to call the undersigned attorney.

The Examiner and Commissioner are hereby authorized to charge any additional fees associated with this Response or refund any overpayments associated with this Response to our deposit account, Deposit Account No. 23-0280.

Respectfully submitted,

Date: 7 December 2005 By: \_\_\_\_\_

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